The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

*Ex parte* MICHAEL L. HOWARD and WILLIAM R. HARPER JR.

_____

Appeal No. 2005-1540
Application No. 09/887,626

_____

ON BRIEF[1]

_____

Before BARRETT, GROSS, and BARRY, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 26, which are all of the claims pending in this application.

Appellants' invention relates to a module and method for enabling an energy provider to send a request to an energy user to curtail energy use. Claim 1 is illustrative of the claimed invention, and it reads as follows:

_____

[1] We note that the hearing scheduled for August 11, 2005, was waived by appellants.

1.   A curtailment module for enabling an energy provider to send
a request to curtail energy use to a user, the curtailment module
comprising:

> an interface for electronic communications with a
>   temperature control device;
>
> a paging module for receiving the request from the energy
>   provider through a paging network;
>
> a processor in electronic communication with the paging
>   module for receiving the request from the paging
>   module; and
>
> memory in electronic communication with the processor, the
>   memory storing history data, and the memory being
>   programmed with verification instructions to generate a
>   verification code to be used by a user to manually
>   verify whether the request was followed, wherein the
>   history data is not the same as the verification code.

The prior art references of record relied upon by the

examiner in rejecting the appealed claims are:

Von Kohorn	5,128,752	Jul. 07, 1992
Hunter	5,243,654	Sep. 07, 1993
Glorioso et al. (Glorioso)	5,926,776	Jul. 20, 1999

Claims 1 through 26 stand rejected under 35 U.S.C. § 103 as

being unpatentable over Glorioso in view of Von Kohorn and

Hunter.

Reference is made to the Examiner's Answer (Paper No. 13,

mailed May 6, 2004) for the examiner's complete reasoning in

support of the rejections, and to appellants' Brief (Paper

No. 12, filed December 12, 2003) and Reply Brief (Paper No. 16, filed July 9, 2004) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellant and the examiner. As a consequence of our review, we will reverse the obviousness rejection of claims 1 through 26.

Appellants indicate on page 4 of the Brief that all of claims 1 through 26 stand or fall together. Since the limitation at issue, a code that is generated for the user to manually verify whether a request from an energy provider has been followed, appears in each of independent claims 1, 11, 16, 20, and 22, we will treat the claims as a single group, as indicated by appellants, with claim 1 as representative.

The examiner contends (Answer, pages 3-4) that Glorioso discloses everything in claim 1 except that it does not specify manual verification by the user. The examiner turns to Von Kohorn, asserting (Answer, pages 4-5) that Von Kohorn "discloses that manual verification has the advantage of reduces capital investment by the absence of two way communication, but may be used with two way communication." Further, the examiner states

3

(Answer, page 5) that it is not clear from the combination if the verification code is the same as history data. The examiner relies on Hunter, stating that it would have been obvious "to have encrypted the history data of Glorioso as disclosed in Hunter in order to provider verification information that is secure, difficult to modify, counterfeit or tamper with." The examiner believes that the encryption of Hunter "corresponds to applicant's 'not the same as.'"

Appellants argue (Brief, page 5) that Glorioso fails to teach or disclose "memory being programmed with verification instructions to generate a verification code to be used by a user to manually verify whether the request was followed." Specifically, appellants first contend that the verifying in Glorioso is not at the user's location, as recited in the claims, but, rather, is at the energy provider. We agree. The portion of Glorioso referenced by the examiner (Answer, page 4) discloses that the energy provider's computer system includes software that includes code for verifying that an action has taken place. There is no suggestion in Glorioso that a code is generated at the user's processor for employment by the user.

Second, appellants argue (Brief, page 6) that Glorioso fails to disclose a verification code. Appellants contend (Brief,

page 6) that since the energy provider performs verification, there is no need for a verification code. We agree.

Third, appellants state (Brief, page 6) that the verification in Glorioso is not manual, nor does it suggest manual verification. We agree. However, the examiner admitted that Glorioso did not teach manual verification, and, therefore, relied upon Von Kohorn and Hunter for such.

Appellants assert (Brief, page 7) that the examiner improperly combined Von Kohorn with Glorioso. Specifically, appellants argue (Brief, page 9) that, Von Kohorn deals with redeeming tokens and uses verification data to determine if a token is valid and whether particular rules were followed. Von Kohorn does not disclose memory programmed with verification instructions to generate a verification code to be used to manually verify whether a request was followed. We agree. Further, appellants contend (Brief, page 13) that there is no motivation to combine the references. Again, we agree.

Regarding Hunter, appellants (Reply Brief, page 2) recognize that Hunter requires manual verification of meter readings. However, appellants argue (Reply Brief, page 3) that "[t]he manual verification and communication of Hunter would not only not work in Glorioso, but it would destroy the very purpose of

the invention in Glorioso because it could not monitor supply and demand in real-time and adjust the prices and further send these prices to users in real-time." Appellants continue (Reply Brief, pages 3-4) that there is no motivation to combine Hunter with Glorioso and Von Kohorn, as the combination would render Glorioso unsatisfactory for its intended purpose.

We agree with appellants that there is no motivation to combine Hunter with Glorioso and Von Kohorn. Glorioso discloses automatic verification of whether the requested action has taken place. We find no suggestion in any of the references as to why a skilled artisan would change the automatic verification to manual verification by the user or to add such a manual verification to the automatic verification disclosed by Glorioso. Accordingly, we cannot sustain the obviousness rejection of claim 1 nor of the claims grouped therewith, claims 2 through 26.

CONCLUSION

The decision of the examiner rejecting claims 1 through 26

under 35 U.S.C. § 103 is reversed.

REVERSED
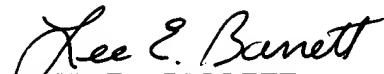
LEE E. BARRETT   )
Administrative Patent Judge   )
)
)
)
)
ANITA PELLMAN GROSS   ) BOARD OF PATENT
Administrative Patent Judge   )   APPEALS
)   AND
)   INTERFERENCES
)
)
)
LANCE LEONARD BARRY   )
Administrative Patent Judge   )
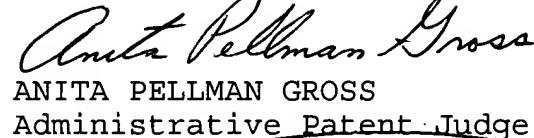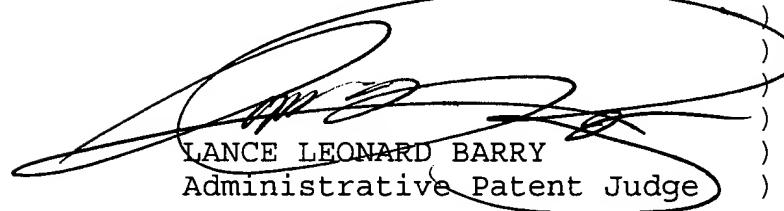
APG/vsh

Appeal No. 2005-1540
Application No. 09/887,626

MADSON & METCALF
GATEWAY TOWER WEST
SUITE 900
15 WEST SOUTH TEMPLE
SALT LAKE CITY, UT 84101